Supreme Court, U. S.
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Supreme Court of the United States

October Term, 1976

No. 76-1628

CHISHOLM-RYDER COMPANY, INC., and
NEW YORK STATE GRAPE PRODUCTION
RESEARCH FUND, INC.,
Petitioners,

vs.

LEWIS MANUFACTURING COMPANY, LEO J.
LEWIS, WILLIAM L. LEWIS, MARK LEWIS and
LEWIS MANUFACTURING COMPANY,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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INDEX.

	Page
Questions Presented	1
Statutes Involved	2
Statement of the Case	3
Argument	6
No Justiciable Issue Raised	6
I. 35 USC 253 and 288 were not relied on in the holding of fraud on the Patent and Trademark Office	6
II. Deliberate concealment of prior art from the Patent and Trademark Office can reasonably be inferred from the facts found by the Court below	9
Conclusion	10

TABLE OF CASES.

Aetna Life Insurance Co. of Hartford, Connecticut v. Haworth (1937) 300 U.S. 227, 240-241	6
Southern Talow Co. v. David J. Joseph and Co. (CCA 5th 1939) 101 F. 2nd 862	6
State *ex rel.* Lemon v. Langlie, as Governor, 273 P.2d 464 (1954)	7

TABLE OF STATUTES.

28 USC 2111	2,6
35 USC 102(b)	2,3,5,8
35 USC 103	2,3,5,8
35 USC 253	1,6,7,8,9
35 USC 288	1,6,7,8,9
FRCP Rule 61	2,6

Statutes Involved

35 USC 102 (b) "CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

"A person shall be entitled to a patent unless—

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

35 USC 103 "CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

28 USC 2111 "HARMLESS ERROR

"On the hearing of any appeal or writ of certiorari in any case, the court shall give judgment after an examination of the record without regard to errors or defects which do not affect the substantial rights of the parties."

FRCP RULE 61 "HARMLESS ERROR

"No error in either the admission or the exclusion of evidence and no error or defect in any ruling or order or in anything done or omitted by the Court or by any of the parties is ground for granting a new trial or for setting aside a verdict or for vacating, modifying, or otherwise disturbing a judgment or order, unless refusal to take

such action appears to the court inconsistent with substantial justice. The court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties."

Statement of the Case

The Patent in suit was issued to Professor Shepardson on April 30, 1968. A parent patent application was filed on March 30, 1961, which was refiled with new matter as a Continuation-In-Part (CIP) application on April 16, 1965 (Appendix to Petition 2a).

The eighteen claims of the Shepardson patent No. 3,380,236 can be divided into four groups:

Group A (Claims 3, 4, 7, 9, 10, 13, 16, 18) were disclaimed subsequent to the filing of the suit but prior to the trial thereon (2a). They were not part of the patent at trial, and no testimony was taken on them.

Group B (Claims 1, 2, 5, 6, 8, 11, 17) were held invalid under Title 35 USC 102 (b) and 103 because of the Grape Belt article, of which the inventor may have been unaware although he was a co-author of the text (27a). This part of the ruling was not appealed by Petitioners.

Group C (Claim 12) covered new matter added by the CIP application (7a). The Courts below held Claim 12 obvious and thus invalid under Title 35 USC 103 (35a). Petitioners appealed as to this part of the ruling. The ruling was affirmed by the Third Circuit Court of Appeals (42a).

Group D (Claims 14, 15) covered new matter added in the CIP application (7a). The Courts below held Group D invalid because of the deliberate non-disclosure of material prior art

known to the inventor which mislead the Patent and Trademark Office (38a). Petitioners appealed as to this part of the ruling. The ruling was affirmed by the Third Circuit Court of Appeals (42a).

The District Court held that Claims 14 and 15 (Group D) were invalid because Professor Shepardson deliberately failed to disclose to the Patent and Trademark Office five pertinent prior art publications (27a, 30a, 38a).

Each item of withheld prior art, all of which were co-authored or supervised by Shepardson, was far more relevant to the subject matter of the application than the prior art known to the Patent and Trademark Office (37a).

The inventor has never explained why this pertinent prior art was not disclosed to the Patent and Trademark Office (30a).

The undisclosed prior art included the following items:

The *Padget Thesis*, dated June, 1959, was written by John Richard Padget under the supervision of Shepardson. It described a mechanical grape harvester with a vertical axis vibrator which employed a clamp to engage the trellis wire (10a).

The *105th Proceedings*, a publication which contained a paper co-authored and read by Shepardson at the 105th Annual Meeting of the New York State Horticultural Society of January 19, 1960. The paper was later published in the 105th Proceedings. This article was identical in text to the Grape Belt newspaper article of March 8, 1960 (15a, 16a), and Shepardson submitted the same text to the United States Patent Office as the first disclosure of his invention in an interference proceeding (29a-30a). It describes a mechanical grape harvester with a vertical axis vibrator and a spiked wheel to engage the trellis wire (9a-10a, 16a-17a).

The *106th Proceedings*, a publication which contained a paper co-authored and read by Shepardson at the 106th Annual Meeting of the New York State Horticultural Society of January 17, 1961. The paper was later published in the 106th Proceedings. The article described a mechanical grape harvester with a vertical axis vibrator and a spiked wheel to engage the trellis wire (10a).

The *Agricultural Engineering* magazine dated February, 1962, contained an article co-authored by Shepardson, which described a mechanical grape harvester with a vibrator with an axis tilted downward and rearward and a spiked wheel to engage the trellis wire (10a) which is the subject of Claim 14.

The *Studer Thesis*, dated February, 1962, was written by Henry Eugene Studer under the supervision of Shepardson, and described a mechanical grape harvester having a vibrator with an axis tilted downward and rearward and with a spiked wheel to engage the trellis wire (11a).

The patent in suit involves a mechanical grape harvester with a vibrator having an axis tilted downward toward the trellis wire and rearward, and having a spiked wheel to engage the trellis wire (3a-5a).

The District Court invalidated eight of the ten retained claims on the ground of prior publications (35 USC 102(b)) or obviousness in view of prior publications (35 USC 103). The remaining two claims were held invalid on the ground of fraud on the Patent Office in view of the deliberate withholding of five pertinent prior art references from the Patent Office by the inventor (30a-31a).

The Court of Appeals affirmed the opinion of the District Court without comment and denied a petition for rehearing *in banc*.

ARGUMENT

No Justiciable Issue Raised

None of the questions raised in the Petition presents a justiciable issue for the Court to decide. It is well settled that the United States Supreme Court will not decide a case, unless there exists a definite and concrete controversy touching the legal relations of the parties having adverse legal interests. Aetna Life Insurance Co. of Hartford, Connecticut v. Haworth (1937) 300 U.S. 227, 240-241.

Further, the harmless error doctrine, as expressed in Federal Rules of Civil Procedure, Rule 61 and Title 28 USC 2111 is that the Court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties. Errors which are technical and of no consequences to the fundamental rights of the parties must be disregarded. If there is no controversy as to rights, which may be substantially affected by error, no reversible error can arise. Southern Talow Co. v. David J. Joseph and Co. (CCA 5th 1939) 101 F. 2nd 862.

Thus, the Supreme Court will not disturb a judgment unless there both exists a concrete controversy between parties with adverse legal interests and an error was made which affected the substantial rights of the parties.

It is submitted that the questions presented do not raise a concrete controversy between the parties and that the errors alleged, if they are errors, are harmless and will not affect the decision of the case at bar.

I. 35 USC 253 and 288 were not relied on in the holding of fraud on the Patent and Trademark Office

Contrary to Petitioner's statements, the Courts below did not apply 35 USC 253 and 288 in its holding that Claims 14

and 15 were invalid. Nor did the Courts below apply these sections to hold invalid any of the claims not disclaimed by the Petitioner. The Courts referred to the disclaimer and its timing only as another fact that tended to indicate that the Petitioner was attempting to secure something to which he was not entitled (36a).

The holding that the Claims 14 and 15 are invalid would remain unchanged regardless of whether or not this Court would find that 35 USC 253 and 288 requires that a disclaimer be filed promptly. Likewise, the holding would remain unchanged whether or not this Court would find that the mere filing of a disclaimer under 35 USC 253 and 288 permits a court to infer that the disclaimed claims were invalid.

The District Court, affirmed by the Appellate Court, held all claims invalid, even though some of the claims were otherwise valid, because of the failure of the inventor to disclose pertinent prior art to the Patent and Trademark Office (27a).

The Courts below then went on to discuss 35 USC 253 and 288. These remarks were in the nature of *Obiter Dictum*. They were made by the judge in pronouncing an opinion on a cause, concerning some rule, principle or application of law, or the solution of a question suggested by the case at bar, but not necessarily involved in the case or essential to its determination. State *ex rel.* Lemon v. Langlie, as Governor, 273 P. 2d 464 (1954).

In the opinion of the United States District Court dated July 17, 1975, at page 30a, the Court made a finding that the failure to disclose the prior art, which was authored or supervised by the inventor, was not inadvertent.

The Court then commented that the inventor has offered no reason why this pertinent prior art was not disclosed to the Patent and Trademark Office before stating several separate conclusions:

1) that the applicant deliberately failed to disclose the prior art;

2) that the undisclosed prior art was material;

3) that the Patent and Trademark Office was misled by the failure to disclose; and

4) that the disclaimer was not promptly made.

The Court then found all claims, except 14 and 15, invalid by reason of prior publication (35 USC 102 (b)) or obviousness (35 USC 103), and found all claims, not otherwise invalid, invalid by reason of the deliberate failure of the applicant to disclose pertinent prior art, which non-disclosure was material and, in fact, misled the Patent and Trademark Office.

Further support for the position that 35 USC 253 and 288 were not relied upon in the Court's finding of fraud is found at Page 27a of the opinion were the Court concluded that the failure to disclose the publications, which he authored, or the theses, which he supervised, was sufficient to render all of the claims invalid.

The conclusions of fraud was reached before the Court undertook a discussion of the possible effect of 35 USC 253 and 288 on the case.

Further support for this position is found in the Court's Memorandum Opinion of March 31, 1976 (34a) which does not even refer to the statute, although the fact of the disclaimer being made was mentioned (36a) in support of the findings of the Court.

A fair reading of the Opinions of the Court below would be that it did not consider 35 USC 253 and 288 to be controlling in its decision, and it did not rely on these sections in its finding of fraud on the Patent and Trademark Office.

II. Deliberate concealment of prior art from the Patent and Trademark Office can reasonably be inferred from the facts found by the Court below

The Courts below reasonably found that Shepardson deliberately concealed the prior art from the Patent and Trademark Office from the facts it found in the case.

The Courts found deliberate concealment by Shepardson of prior art based on much more than the facts that he had knowledge of such prior art. First of all, there was the volume of this prior art, five separate and complete prior art references. The Courts also found that Shepardson had a duty to disclose pertinent prior art to the Patent and Trademark Office (37a).

The Courts further found that each of the undisclosed prior art references was more material than any of the art known to the Patent and Trademark Office (37a), and that Shepardson, who either co-authored or supervised all of the undisclosed references, knew of the references and knew that they were pertinent (25a-26a).

The Courts also found that Shepardson, throughout the long history of the prosecution of the application, never disclosed these prior art references to the Patent and Trademark Office; and that Shepardson has never offered any explanation as to why these references were not disclosed (30a).

The Courts also noted that Shepardson made no effort to disclaim any claims of his patent throughout the long pendency of the application, during the interference proceeding and until a year after this suit was filed and the prior art references were discovered (29a).

On the basis of these facts, the Court below properly found that all of the claims were invalid (27a, 30a) because Shepardson deliberately concealed pertinent prior art from the Patent and Trademark Office.

The Court below properly held invalid all of the claims of Petitioners' patent in suit under the law and the facts of the case. Substantial justice has been done between the parties. There is no substantial issue raised to warrant granting this Petition for a Writ of Certiorari.

Conclusion

Respondents respectfully request that this Petition for a Writ of Certiorari be denied.

Respectfully,

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